



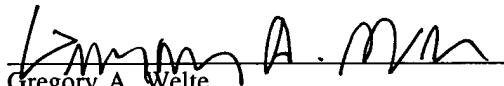
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Assignee's Docket No.: 8717.00)
Group Art Unit: 3622)
Serial No.: 09/826,680)
Examiner: Daniel Lastra)
Filing Date: April 5, 2001)
Title: Self Service Terminal)

CERTIFICATE OF MAILING

I certify that this document is addressed to Mail Stop AF, Commissioner of Patents, PO Box 1450, Alexandria, VA 22313-1450, and will be deposited with the U.S. Postal Service, first class postage prepaid, on June 11, 2008.


Gregory A. Welte

REPLY BRIEF TO SUPPLEMENTAL EXAMINER'S ANSWER

This is a Reply Brief under 37 CFR § 41.43(b).

Identification of References for Clarity

Three references are relevant.

Drummond Application

The rejections are based on Drummond '888 ("Drummond Application" herein). This is a published U.S. application.

Drummond Patent

The Drummond Application, above, is a divisional of Drummond 7,080,036 ("Drummond Patent").

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Provisional '765

The Drummond Patent, above, claims priority of a provisional, namely, "Provisional '765."

Examiner's Contention

The Examiner asserts that the Drummond Application is entitled to the filing date of Provisional '765.

Basic Issue

The Drummond Application may discuss retrieval of advertising at an ATM, and display of the advertising.

However, Applicant's filing dates precede those of the Drummond Application.

Thus, for the retrieval and display of the advertising to be used against Appellant's claims, those concepts must be shown in Provisional '765.

That has not been done.

Point 1 (A Technical Issue with the Answer)

Appellant filed an Appeal Brief. Then the Examiner filed an Answer. Then Appellant filed a Reply Brief to the Answer.

After all that, on April 11, 2008, the PTO mailed a document entitled "Examiner's Answer," which states on page 1:

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This is in response to the appeal brief
filed 04/23/2007 appealing from the Office
action mailed 07/13/2006.

Appellant points out that, as stated above, an Examiner's Answer has already been filed in response to the Appeal Brief, and a Reply Brief to that Answer has also been filed.

Under the rules, the latest Answer (mailed April 11, 2008) must be classified as a Supplemental Examiner's Answer, under 37 CFR § 41.43(a).

Under rule 41.43(a), the Supplemental Examiner's Answer is required to "respond to any new issue raised in the reply brief." The Supplemental Examiner's Answer does not appear to do this, nor does it appear to mention the Reply Brief at all.

Point 2

The Examiner repeatedly asserts that the **ENTIRE** Drummond Application is entitled to the filing date of Provisional '765.

That is, the Examiner is asserting that **EVEN IF THE DRUMMOND APPLICATION IS A CIP**, nevertheless, the **NEW MATTER** in the CIP is entitled to the filing date of the parent, namely Provisional '765.

That assertion defies common sense. The reason is that the new matter may **never have existed** on the filing date of Provisional '765.

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IT IS AXIOMATIC THAT SUBJECT MATTER ON WHICH
A REJECTION IS BASED
MUST BE IN EXISTENCE ON THE EFFECTIVE DATE
OF THE REFERENCE USED TO SHOW
THAT SUBJECT MATTER

This axiom has not been followed.

The retrieval and display of the advertising, for example, have never been shown in Provisional '765, whose date is being used as that of the Drummond Application.

Point 3

The Supplemental Examiner's Answer, page 8 et seq., asserts that the Drummond Application is a divisional, and is entitled to The filing date of the Drummond Patent (August 14, 2000).

Appellant points out that Appellant is entitled to his filing date in Great Britain, which is April 7, 2000.

Thus, Appellant has beaten the filing date of the Drummond Patent.

Point 4

The Supplemental Examiner's Answer, page 9, asserts that the Drummond patent is entitled to the filing date of Provisional '765.

However, MPEP

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§ 2136.03 (IV),

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§ 706.02(f)(1)(B),

and other sections

specifically state that such a date is available **only if the prior provisional provides support for Appellant's claims.**

This support has not been shown.

The retrieval and display of the advertising, for example, have never been shown in Provisional '765, whose date is being used.

Point 5

The Supplemental Examiner's Answer, page 10, line 9, states that the Examiner "corroborates" that Provisional '765 has "complete support for the Drummond 888 reference."

Appellant points out that this "corroboration" is no substitute for evidence. Appellant is aware of no statutory provision which allows a rejection to be based on an Examiner's interpretation of a reference, when the reference itself has not been supplied.

The burden of proof is on the Examiner.

Point 6

The Supplemental Examiner's Answer, page 9, seventh line from bottom et seq., cites 37 CFR § 1.14, and implies that this regulation requires Appellant (1) to obtain a copy of Provisional

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'765, and then (2) rebut the Examiner's undocumented assertion that Provisional '765 contains the necessary content.

In response, Appellant points out the following.

First, this regulation states that the PTO **"MAY"** provide a copy of Provisional '765 in question. That is, no legal right is given to Appellant to obtain Provisional '765.

Second, the PTO does not follow this regulation. This is proven by the following facts.

In previous proceedings in this application, the PTO attempted to rely on the filing date of another Drummond application, namely, 09/193,787 ("787"), which is a parent of both the Drummond Application and the Drummond Patent. (Both claim the benefit of the filing date of "787.")

The undersigned attorney attempted, through a representative, to obtain a copy of the "787" application, to determine whether it contains subject matter to support the previous rejection. The PTO refused to provide a copy. The stated grounds were that the application had been revived, and thus the application was not available to the public.

This is stated in Appellant's Amendment, mailed March 23, 2005, page 14, section entitled "Drummond '888 Not Available as Reference."

This refusal is contrary to the regulation cited by the Examiner. To repeat: The requested "787" application is an

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application whose filing date was sought to benefit both the Drummond Application and the Drummond Patent, and is thus covered by the regulation cited by the Examiner. The PTO refused to supply a copy.

Therefore, since

-- Appellant has no legal right to obtain
Provisional '765,

and

-- the PTO has refused on a prior occasion to
supply an analogous application to Appellant,
when requested, (ie, the "787" application)

Appellant submits that the PTO is confronted by an estoppel.

Appellant submits that the PTO is estopped to assert that Appellant has the burden of physically obtaining Provisional '765 in question.

Appellant also submits that the PTO is estopped to assert that Appellant has the burden of disproving the Examiner's unsupported assertion that Provisional '765 contains the necessary subject matter to support the rejection.

Appellant submits that this latter estoppel is independently supported by the fact that the initial burden is on the Examiner. Certain claimed subject matter has not been shown in a reference having a proper effective date. The initial burden has not been met.

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Point 7

The Drummond Application is 84 pages in length.

The Drummond Patent is 83 pages in length.

If Provisional '765 has "complete support" for Drummond 888, as the Supplemental Examiner's Answer asserts (page 10, line 10), then Provisional '765 will be of similar length.

37 CFR § 1.104(c)(2) states:


When a reference is **complex** or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable.**

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This regulation requires that the Examiner identify the sections in Provisional '765 which contain the subject matter needed to support the rejection.

That has not been done.

Respectfully submitted,


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